

REMARKS

Applicants reply to the Office Action mailed on July 29, 2005, within the shortened statutory period for reply. Claims 1-12 were pending and the Examiner rejects claims 1-12. In reply, Applicants amend claims 1 and 4-10, cancel claim 3, add claims 13-17 and address the Examiner's remarks. Support for the amendments may be found in the originally-filed specification, claims, and figures. No new matter has been introduced by these amendments. Reconsideration of this application is respectfully requested.

DOUBLE PATENTING

The Examiner provisionally rejects claims 1-12 over claims 1-12 of co-pending Application Serial No. 10/708,838 (U.S. Patent Application No. 2004/0233039). While Applicants respectfully disagree with this double patenting rejection, in the interest of compact prosecution, Applicants submit a terminal disclaimer, without prejudice, in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this non-statutory double patenting rejection is based on the above-listed application, which is commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

35 U.S.C. § 103 REJECTIONS***Rejections Under 35 U.S.C. § 103 (a)—the Black Reference***

The Examiner rejects claims 1-3 and 5-7 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Black, U.S. Patent Application No. 2005/0122209 ("Black"). The Examiner notes that, "Re claim 1, Black teaches a method for registering biometric information for use with a smartcard system, the system comprising: a biometric sensor configured to detect a proffered biometric sample; a device configured to associate the proffered biometric sample with user information and smartcard information to create a data packet; and a database configured to store the data packet, wherein the database is configured to communicate with the system (FIG. 1A, 1C, 5A, abstract, which teaches proffering a biometric sample and associating the information with user and smartcard/transponder information to create a data packet FIG. 10A-11 B, 14A, 14B.)" (Pages 6-7). Applicants respectfully traverse this rejection.

In general, Black discloses an identity authentication system comprising a device for capturing a customer signature. Black requires a user to provide an electronic signature using a

stylus or other similar device ([0016], [0022]). Further, while Black discloses submitting personal data during the registration procedure (Fig. 5A), Black only discloses such personal data to be customer record numbers, customer bank, account numbers, account balance, reference prints and reference signatures (Fig. 10A-B, 11A-B).

Further still, Black is limited to associating a single transaction account with the customer record (Figs. 10A-B, 11A-B, [0087]). That is, Black is limited to having a smartcard consisting of only one "customer account that is to be used for payment" ([0084]), and not a smartcard with multiple credit and/or debit accounts. Thus, Black does not teach or disclose at least "a device configured to associate said proffered biometric sample with user information and smartcard information to create a data packet, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account, a PayPal account, a membership account, a Western Union account, an electronic bill payment account, an automatic bill payment account and a loyalty point account," as recited in independent claim 1.

Applicants cancel claim 3. Claims 2 and 5-7 directly depend from claim 1 and contain all of the elements thereof. Therefore, Applicants assert that claims 2 and 5-7 are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2 and 5-7.

Rejections Under 35 U.S.C. § 103(a)—the Black and Maritzen References

The Examiner rejects claims 4 and 9-11 as being unpatentable over Black, as discussed above, in view of Maritzen, et al., U.S. Patent Application No. 2002/0191816 ("Maritzen"). Applicants respectfully traverses this rejection.

Neither Black, Maritzen, nor any combination thereof, teach or disclose at least "a device configured to associate said proffered biometric sample with user information and smartcard information to create a data packet, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account, a PayPal account, a membership account, a Western Union account, an electronic bill

payment account, an automatic bill payment account and a loyalty point account," as recited in independent claim 1. Moreover, claims 4 and 9-11 directly depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 4 and 9-11 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 4 and 9-11.

Rejections Under 35 U.S.C. § 103(a)—the Black and Moebs References

The Examiner rejects claim 8 as being unpatentable over Black, as discussed above, in view of Moebs et al, U.S. Patent Application No. 2005/0065872 ("Moebs"). Applicants respectfully traverse this rejection.

Neither Black, Moebs, nor any combination thereof, teach or disclose at least "a device configured to associate said proffered biometric sample with user information and smartcard information to create a data packet, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account, a PayPal account, a membership account, a Western Union account, an electronic bill payment account, an automatic bill payment account and a loyalty point account," as recited in independent claim 1. Moreover, claim 8 directly depends from claim 1 and contains all of the elements thereof. Therefore, Applicants respectfully submit that claim 8 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 8.

Rejections Under 35 U.S.C. § 103(a)—the Black and Machida References

The Examiner rejects claim 8 as being unpatentable over Black, as discussed above, in view of Machida, U.S. Patent Application No. 2004/0131237 ("Machida"). Applicants respectfully traverse this rejection.

Neither Black, Machida, nor any combination thereof, teach or disclose at least "a device configured to associate said proffered biometric sample with user information and smartcard information to create a data packet, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge

card account, a credit card account, a debit card account, a savings account, a private label account, a PayPal account, a membership account, a Western Union account, an electronic bill payment account, an automatic bill payment account and a loyalty point account," as recited in independent claim 1. Moreover, claim 12 indirectly depends from claim 1 and contains all of the elements thereof. Therefore, Applicants respectfully submit that claim 12 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 12.

NEW CLAIMS 13-17

New claims 13-17 depend from claim 1 and contain all of the elements thereof. Therefore, Applicants assert that new claims 13-17 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features.

CONCLUSION

Applicants respectfully submit that the pending claims are in condition for allowance. No new matter is added in this Reply. Reconsideration of the application is thus requested. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814. Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

Dated: August 29, 2005

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